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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,391	09/24/2001	Hiroko Suzuki	DAIN:493A	7852

7590

06/02/2003

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EXAMINER
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JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/960,391

Applicant(s)

SUZUKI ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/266,578.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The amendment filed 3/17/03 has been entered. Claims 22-26 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 22-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 22 recites the limitation “a transparent conductive layer comprising a reaction product of a conductive composition comprising conductive fine particles and a reaction curing resin” on line 4-6. However, the instant disclosure at the time of filing does not teach or suggest to one having ordinary skill in the art that the conductive layer is formed from a reaction product of the conductive composition and the reaction curing resin as instantly claimed. Based on the instant disclosure and the working examples, it appears that the conductive fine particles are merely dispersed in the reaction curing resin and do not react with the reaction curing resin, and hence, the product produced is not a reaction product of the conductive composition and the reaction curing resin as instantly claimed but a reaction product of only the reaction curing resin.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al (USPN 5,925,438) in view of Niimi et al (USPN 6,146,753) wherein the Examiner takes the position that the transparent conductive layer of the instant invention is the reaction product of a reactive curing resin having conductive fine particles dispersed therein. The teachings of Ota et al are discussed in detail in the paragraph 3 of the prior office action. Though Ota et al teach an anti-reflection film comprising a transparent substrate, a transparent conductive layer on the substrate, a hardcoat layer formed on the transparent substrate through another layer and a low refractive-index layer formed on the hardcoat layer, Ota et al teach that the transparent conductive layer is formed by sputtering a metal oxide layer as opposed to the reaction product of a reactive curing resin having conductive fine particles dispersed therein as instantly claimed. However, Niimi et al teach that forming a conductive layer by sputtering a metallic oxide layer as taught by Ota et al and forming a conductive layer comprising conductive fine particles and a reaction-curing resin composition as in the instant invention are functionally equivalent in the art in terms of a transparent conductive layer, wherein Niimi et al further teach that the reaction-curing resin is preferably selected such that it has good adhesion to the substrate film and good adhesion to a subsequent layer applied (Col. 3, lines 19-46.) Therefore, one having ordinary skill in the art at the time of the invention would have been motivated to utilize a transparent

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conductive layer formed from conductive fine particles and a reaction-curing resin composition given that it is a known functionally equivalent transparent conductive layer to a sputtered deposited metal oxide layer in the art as taught by Niimi et al.

### ***Double Patenting***

7. Claims 22-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8, and 14 of U.S. Patent No. 6,319,594 in view of Niimi et al and in further view of Ota et al (USPN 5,925,438.) Though the conflicting claims are not identical, they are not patentably distinct given that Niimi et al teach that a transparent conductive layer having good adhesion to a transparent substrate can be formed by a reaction curing resin comprising conductive fine particles and hence one having ordinary skill in the art at the time of the invention would have been motivated to utilize the transparent conductive layer taught by Niimi et al for the invention claimed in Patent '965. Further, in terms of the resulting product, a single layer of a hardcoat material having a particular thickness is equivalent to a plurality of adjacent hardcoat layers having a combined thickness of the single hardcoat layer and therefore it would have been obvious to one skilled in the art at the time of the invention to provide multiple coatings of the hardcoat layer in USPN '594 to provide a hardcoat layer with the desired thickness/hardness for a particular end use wherein it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In *re Harza*, 124 USPQ 378 (CCPA 1960.) In addition, Ota et al teach that the hardcoat layer of antireflection film can be provided as a laminate composed of a plurality of layers in order to

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improve the hardness of the hard coat layer (Col. 7, lines 44-47.) Further, with regards to Claim 23, Ota et al teach that fine roughness or irregularities on the outermost surface of an antireflection film imparts thereto beneficial antiglaring properties wherein the roughness is produced on the surface of the underlying hardcoat layer as well and hence one skilled in the art at the time of the invention would have been motivated to provide the outermost surface low refractive layer and the underlying hardcoat layer with fine roughness or irregularities to impart antiglaring properties to the antireflective film.

***Response to Arguments***

8. Applicant's arguments with respect to claims 22-26 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner would like to comment with respect to Applicant's remarks regarding the alleged advantageous properties of utilizing a transparent conductive layer as instantly claimed. In the remarks filed 3/17/03, the Applicant states that "the specification at page 5, lines 3 to 8, contains a discussion that using the transparent conductive layer as claimed is advantageous because there is good adhesion to both the substrate film and the hardcoat layer, thereby enhancing the quality of the claimed low reflective antistatic hardcoat film." However, the Examiner notes that the section of the specification cited by the Applicant, Page 5, lines 3-8, does not recite "advantageous" properties of utilizing this type of transparent conductive layer over other types of transparent conductive layers as stated by the Applicant but only states that any reaction curing resin may be used so far as the resin has good adhesion to the substrate film and is resistant to light and moisture, and has good adhesion to the hardcoat layer formed on the transparent conductive layer. Nowhere in the

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cited section does it teach or imply that this type of transparent conductive layer provides “advantageous” properties.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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A handwritten signature in black ink, appearing to read 'M. Jackson', with a stylized, flowing script.

Monique R. Jackson  
Patent Examiner  
Technology Center 1700  
June 1, 2003